UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/417,864	10/13/1999	LOA ANDERSSON	2204/189	8056

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EXAMINER
GEORGE, KEITH M

ART UNIT	PAPER NUMBER
2663	

DATE MAILED: 07/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

	Application No.	Applicant(s)
●	09/417,864 ●	ANDERSSON ET AL.
Office Action Summary	Examiner	Art Unit	
	Keith M. George	2663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _08 May 2003_ .

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-54_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-54_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _13 October 1999_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
           application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _7_ .	6) ☐ Other:

DETAILED ACTION

Claim Objections

1.   Claim 25 is objected to because of the following informalities: The claim references

claim 145, it should probably reference claim 14. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1, 4-6, 8-14, 17-19, 21-26, 29-31, 33-39, 43-46 and 50-53 are rejected under 35

U.S.C. 103(a) as being unpatentable over DeSimone et al., U.S. Patent 6,212,548 (hereinafter

DeSimone).

4.   Referring to claims 1, 13, 14, 26, 38, 39, 46 and 53, the method of managing a virtual

private network according to the applicant is clearly identical to the method of managing an

internet chat session as described by DeSimone. DeSimone teaches that Internet Relay Chat

(IRC) allows two or more users to converse through a "channel" or virtual "chat room" and that

the chat rooms can also be set up as private chat rooms by participants seeking to have private

communications with a selected one or more other participants. DeSimone goes on to teach that

entering a particular chat room is typically effected using a list or menu of currently available

chat rooms (column 1, lines 25-62). DeSimone also teaches in figures 4A, 4B, 4C, 5A, 5B, and

5C, that all users are aware of all other users by the names following "IN ROOM:" (identify all

network devices in the set of network devices). A notify message, "** DAVE ADDED **" is

sent to all devices when a new device is added as seen in figures 5A and 5B (forward a notify

message to each network device in the set of network devices). A join message, "**

WELCOME **", is sent to the new device (forward a join message to the given network device)

as well as a list of all others in the room, "IN ROOM: DAWN, MIKE, DAVE" (including the set

of network device identifiers), as shown in figure 5C. DeSimone teaches all of the above with

the possible exception of receiving a request to join a given private network and storing the

network device identifiers in a network device memory set. However, at the time the invention

was made, it would have been obvious to a person of ordinary skill in the art that a user would

select a room from the list described above and a request would go to a server requesting

permission to enter the room. It would have also been obvious that the names of all those

present in the room are stored in a database. One of ordinary skill in the art would have been

motivated to do this because the list of chat rooms must reside on a server of some type and by

selecting one of the rooms, a request must be sent requesting access to the room. It also would

have been obvious to store the names of each member of a chat room in a database in order to

forward the names of the current users along to a new user (columns 8-9). Although the method

of DeSimone is directed towards an internet chat session and not to a virtual private network, it

would be clear to one of ordinary skill in the art to use the teaching of DeSimone in

communicating a variety of messages and in communicating mixed-mode messages (column 15,

lines 54-63) including messages used to set up a virtual private network.

5.   Referring to claims 4, 12, 17, 25, 29 and 37, DeSimone teaches the method as shown in

claims 1, 14 and 26 above where it was stated that entering particular chat rooms is typically

effected using a list or menu of currently available chat rooms. By selecting the name of the chat

room the request must include an identifier to select the appropriate room.

6.   Referring to claims 5, 18 and 30, DeSimone teaches the method as shown in claims 1, 14

and 26 above and also teaches the pseudo code shown in column 7 which clearly shows the

behavior of the system when a new room is created and the chat room is added to the list of

active chat rooms.

7.   Referring to claims 6, 19 and 31, DeSimone teaches the method as shown in claims 1, 14

and 26 above and also teaches that the chat application in use is Internet Relay Chat (IRC) which

clearly runs on the Internet, which is well known in the art to be a packet based network.

8.   Referring to claims 8, 21 and 33, DeSimone teaches the method as shown in claims 1, 14

and 26 above and also teaches that each user in a conversation has a unique identifier associated

with the user. This user identifier may be assigned specifically for the session or may be

persistently associated with the user. Examples include an e-mail address or an Internet Protocol

(IP) address (column 5, lines 40-45).

9.   Referring to claims 9, 22, 34, 43 and 50, DeSimone teaches the method as shown in

claims 1, 14, 26, 39 and 46 above and also teaches in figures 6A, 6B and 6C the process that

occurs when a user leaves the chat room. A message is forwarded, "** MIKE DROPPED **",

to each of the remaining members of the chat room. The pseudo code for this process is shown

in columns 12-13.

10.   Referring to claims 10, 23, 35, 44 and 51, DeSimone teaches the method as shown in

claims 9, 22, 34, 43 and 50 above and also teaches in figure 6B that the user that dropped is no

longer connected to the current chat room.

11.   Referring to claims 11, 24, 36 and 45, DeSimone teaches the method as shown in claims

9, 23, 34 and 43 above and also teaches that there is a mechanism present to ensure that a request

to leave a chat room from a participant is confirmed and that only the concerned participant is

issuing the request (column 13, lines 31-34). Although DeSimone is silent on the specifics of

this message, one of ordinary skill in the art would find it obvious to add the list of connected

devices to this message to ensure all connections are dropped and that any participant in that chat

room can not drop anybody else (column 13, lines 34-35).

12.   Claims 2, 3, 7, 15, 16, 20, 27, 28, 32, 40-42, 47-49 and 54 are rejected under 35

U.S.C. 103(a) as being unpatentable over DeSimone as applied to claims 1, 14, 26, 39 and 46

above, and further in view of J. Oikarinen, RFC 1459, Internet Relay Chat Protocol (hereinafter

Oikarinen).

13.   Referring to claims 2, 3, 15, 16, 27, 28, 40, 41, 47, 48 and 54, DeSimone teaches the

method as described in claims 1, 14, 26, 39 and 46 above with the possible exception of detailing

exactly how communication is established between an existing chat room and a new user

wishing to join the room. However, both DeSimone and Oikarinen make it very clear that a

communication path is established between the devices. This can easily be seen in 4-6 of

DeSimone and section 4.2.1 of Oikarinen. One of ordinary skill in the art would be motivated to

establish communication between devices that wish to speak to each other in order that they may

speak to each other. At the time the invention was made, it would have been obvious to one of

ordinary skill in the art to have the requesting device connect to the existing network or to have

the existing network connect to the requesting device.

Referring to claims 7, 20, 32, 42 and 49, DeSimone teaches the methods as shown in claims 1,

14, 26, 39 and 46 above with the possible exception of a method to authenticate the request to

confirm the identity of a network device. Oikarinen teaches a password message for use in IRC

that must be set before any attempt to register the connection is made (section 4.1.1). At the time

the invention was made, it would have been obvious to a person of ordinary skill in the art to use

the password feature of Oikarinen in the system of DeSimone. One of ordinary skill in the art

would have been motivated to do this in order to give some level of security to the actual

connection (Oikarinen, section 4.1).

Response to Arguments

14.   Applicant's arguments filed 8 May 2003 have been fully considered but they are not

persuasive.

15.   On Page 2 of the Response Under 37 CFR 1.111, referring to claim 1, applicant argues

that VPNs are networks that have the look, feel, and security of a private network; however, they

are actually deployed across third party networks, such as the Internet. Similarly, DeSimone

teaches a private chat room (VPN) set up by a participant seeking to have private text

communications with a selected one or more other participants. The server provides a separate

chat room or channel not accessible by anyone not invited by those in the established private chat

room (column 1, line 60 - column 2, line 3). DeSimone has also established the chat rooms are

maintained on one or more chat servers and accessed via an on-line service (column 1, lines 30-

31). One of ordinary skill in the art would know that by on-line service, DeSimone is indicating

a method by which a computing device is connected to the Internet. One of ordinary skill in the

art would also know that the Internet is a public network, contrary to applicant's argument on

page 3 that DeSimone's chat room application is agnostic as to whether the application traverses

a public or private network. Therefore, it is clear that DeSimone is teaching a communication

network that has the look, feel, and security of a private network (private chat room) that is

deployed across a third party network (Internet).

16.   Applicant continues to argue that DeSimone does not at all address any issues associated

with management of VPNs. This may be possible, however, the recitation of managing a virtual

private network has not been given patentable weight because the recitation occurs in the

preamble. A preamble is generally not accorded any patentable weight where it merely recites

the purpose of a process or the intended use of a structure, and where the body of the claim does

not depend on the preamble for completeness but, instead, the process steps or structural

limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976)

and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

17.   Applicant also argues that DeSimone does not address the issue of addition or removal of

network devices from a VPN. Having already established a private chat room not accessible by

anyone not invited by those in the established private chat room, it is clear that DeSimone is

teaching a private network established over a public network (Internet); DeSimone also clearly

teaches the addition and removal of users to the chat room as explained in reference to claim 1

above.

18.   Applicant argues on pages 3-4 of the response that DeSimone is not directed towards

network setup but is directed only toward an application that happens to send messages across a

network that is already set up. It has been shown that DeSimone clearly teaches setting up a

private chat room by a participant seeking to have private text communications with a selected

one or more other participants. Clearly this private chat room is not already set up, but is set up

at the request of a participant. DeSimone goes into detail, as described in reference to claim 1

above, on how a private chat room is set up.

19.   The remaining independent claims 14, 26, 39, 46 and 53 and dependent claims 4-6, 8-13,

17-19, 21-25, 29-31, 33-38, 43-45 and 50-52 are similarly rejected under DeSimone.

20.   Referring to claims 2, 3, 7, 15, 16, 20, 27, 28, 32, 40-42, 47-49 and 54, applicant argues

that Oikarinen does not address management of VPNs. In response to applicant's arguments, the

recitation of managing a virtual private network has not been given patentable weight because

the recitation occurs in the preamble. A preamble is generally not accorded any patentable

weight where it merely recites the purpose of a process or the intended use of a structure, and

where the body of the claim does not depend on the preamble for completeness but, instead, the

process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190

USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA

1951).

Conclusion

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy

as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing
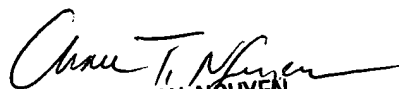
date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Keith M. George whose telephone number is 703-305-6531. The

examiner can normally be reached on M-Th 7:00-4:30, every other F 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Chau T. Nguyen can be reached on 703-308-5340. The fax phone numbers for the

organization where this application or proceeding is assigned are 703-872-9314 for regular

communications and 703-872-9315 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is 703-305-4750.

Keith M. George
July 23, 2003

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